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# In the Supreme Court of the United States

OCTOBER TERM 1949.

## No. 672.

THE HYGIENIC PRODUCTS COMPANY,
*Petitioner,*

vs.

JUDSON DUNAWAY CORPORATION,
*Respondent.*

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT.

## PETITIONER'S REPLY BRIEF.

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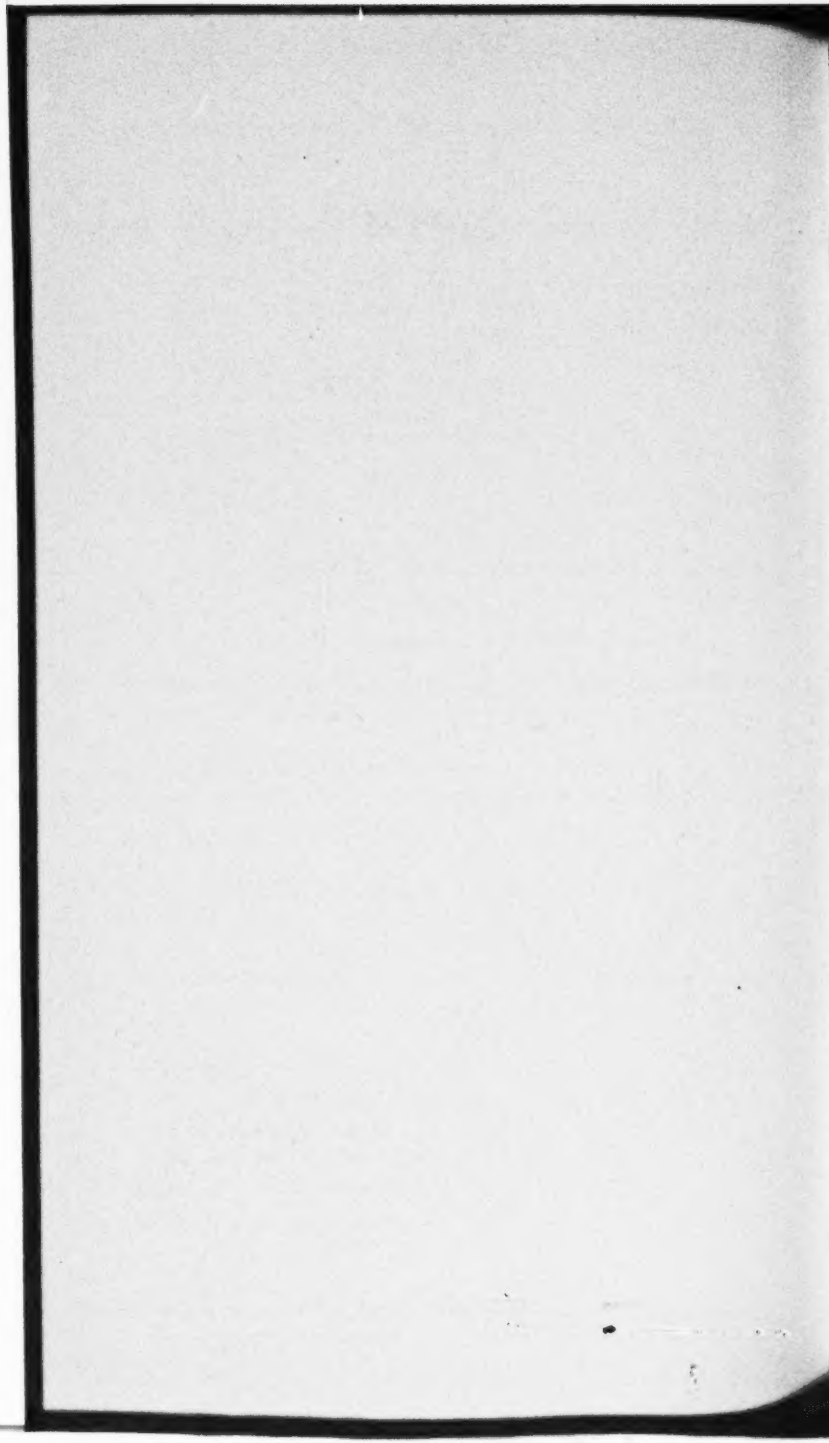

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## PETITIONER'S REPLY BRIEF.

### RE RESPONDENT'S "STATEMENT OF CASE."

For the most part, respondent's "Statement of Case" merely reiterates, though more briefly, the facts which we stated in the petition and supporting brief.

Respondent does refer (Brief pp. 4, 5) to respondent's advertising and to the testimony of its witness, Professor Borden, with respect to figures on advertisements appearing in four magazines—testimony which is not discussed in the petition or supporting brief, as we did not think it pertinent. It is significant that respondent refrains from advising this Court that Professor Borden's figures are confined solely to the *October, 1947* issues of the four magazines (R. 155). This was *thirty six years after* petitioner adopted its picture trade-mark, and also was after this action was filed. The record does not show anything as to the accepted general advertising practice in 1911, nor in 1937 when respondent entered the field. The record shows nothing (other than recognization of and respect for peti-

tioner's rights, R. 110, 112), as to the advertising practices of petitioner's and respondent's competitors engaged in manufacturing and selling cleaning materials for auto radiators and toilet bowls. The record does not show whether any of the advertising pictures referred to by Professor Borden had been long exclusively used by the producer of the product. Nor does it show whether any of the pictures had been registered as a trade-mark. Professor Borden's figures come to naught.

We do, however, appropriately quote here a significant sentence from Professor Borden's testimony (R. 164):

> "It is my observation that not more than half give the name of the companies; *whenever a trade-mark is well known, highly individualized mark,* it is very common to leave the name of the company off, and many of the products, from surveys, *we know that consumers do not know the name of the companies that make these trade-mark articles.*" (Emphasis ours);

and also quote from related findings of the District Court:

> "The defendant's newspaper advertisements and display cards do not in any way display the defendant's name * * *" (R. 220);

and

> "The motive prompting the defendant to use the objected to advertisements was to increase its sales * * *" (R. 231) [as admitted by its president (R. 197-8)].

Furthermore, the fact that petitioner commonly uses its registered picture trade-mark and similar pictures in advertising its own product does not destroy the scope of protection to be afforded petitioner's valid picture trade-mark rights based on continuous and exclusive use of the trade-mark since 1911. The use of a picture trade-mark in advertising is a common and proper merchandising practice "to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears." *Mishawaka Mfg. Co. v. Kresge Co.*, 316 U. S. 203, 205 (1942).

**RE RESPONDENT'S "ARGUMENT."**

Respondent's brief does not in any way attempt to answer the propositions and authorities presented and discussed in petitioner's supporting brief. Indeed, there is no reference to the supporting brief nor to any of petitioner's authorities, except one.

On page 6 of its brief respondent says that "petitioner's pictorial representation is clearly descriptive," which of course is directly contrary to the findings of not only the District Court (R. 234) but also of the Court of Appeals (R. 290). Respondent ignores these findings and our authorities supporting them. It does not directly challenge our position that the trade-mark, in its essential ensemble with prominent characteristics, must be considered as a whole.

On page 7 of respondent's brief, respondent quotes from the Court of Appeals' decision that "a mere representation of a can with powdered material flowing from it into a water closet bowl could not constitute a valid trademark * * *" (R. 289). The Court of Appeals also said, however, that "this does not establish that the plaintiff's marks are invalid * * *" (R. 289). We have no quarrel with these statements. Respondent had used such mentioned "representation" of material flowing from a can into a toilet bowl for 10 years without any complaint from petitioner (R. 290).

The respondent quotes from the Court of Appeals' so-called "second proposition" with respect to what "A mere glance at the advertising section" of a newspaper or periodical shows, but failed to quote the next succeeding sentence which reads:

> "Of course, the defendant cannot represent its product in use in such a setting, or in such a way, as to render it likely that the purchasing public will confuse its product with that of the plaintiff." (R. 291.)

On page 8 of its brief respondent states that the "likelihood of consumer confusion is the proper test of infringe-

ment''—a test that we also asserted in petitioner's main brief (p. 18). Respondent disregards the rule that it is not enough ''to make merely a side by side visual comparison'' and that the purchaser's ''memory'' test should be applied [*Pro-Phy-Lac-Tic Brush Co. v. Jordan Marsh Co.*, 165 F. 2d 549, 552 (C. C. A. 1)]. Instead, respondent merely quotes from *Kellogg Company v. National Biscuit Company*, 305 U. S. 111; *Prestonettes v. Coty*, 264 U. S. 359, and *Coca Cola Co. v. Snow Crest Beverages*, 162 F. 2nd 280 (C. C. A. 1), all of which are clearly distinguishable from the facts of the instant case. In the *Kellogg* case the plaintiff had not used for many years the words ''Shredded Wheat'' as a trade-mark and the words became dedicated to the public upon expiration of the plaintiff's patents. In the *Coty* case the defendant purchased from ''Coty'' the genuine powder which defendant used. In the *Coca-Cola* case defendant's mark ''Polar Cola'' was held to be dissimilar from plaintiff's registered trade-mark ''Coca Cola,'' whereas in the instant case respondent admits that its picture representation is ''similar'' to petitioner's registered mark (R. Brief 6).

Respondent also argues, in effect, that because the labels on its cans are different and some of the background of its accused pictures is different from petitioner's can and picture trade-mark, there can be no confusion and hence no infringement. Respondent does not, because it could not, answer our authorities appearing on pages 21 and 22 of petitioner's supporting brief that ''mere differences in the package or dress will not prevent infringement of a *registered* mark, if it is in fact colorably imitated''—quoting from *Sierra Chemical Co. v. Berettini*, 33 F. 2d 397, 399, (C. C. A. 7, 1929). (Emphasis ours.)

Finally respondent advances (p. 10) the untenable argument that because this Court, during the past five years has denied 40 petitions out of 43, the writ should not issue in the instant case. Its counsel obviously think more highly than they pretend of the questions presented by and reasons relied upon for the grant of a writ.

We submit that we have demonstrated in our brief in support of the petition that petitioner's questions have not been specifically passed upon by this Court, and that they are important and unsettled questions relating to the entire field of picture trade-marks; and further that the decision of the Court of Appeals is in conflict with decisions of this and other Courts including, among others, *McLean v. Fleming*, 96 U. S. 245; *Thaddeus Davids Co. v. Davids Mfg. Co.*, 233 U. S. 461; *Beckwith v. Commissioner of Patents*, 252 U. S. 538; and *Walling v. General Industries Co.*, 330 U. S. 545. Furthermore, respondent's contentions come somewhat with poor grace, as respondent has filed its cross-petition, No. 681, asserting, in effect, that there are present unsettled questions of Federal Law having general application to the field of picture trade-marks and of great importance to trade-mark owners and the general public.

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We again respectfully urge that a writ of certiorari issue to review the judgment of the Court of Appeals for the First Circuit, in this action.

Respectfully submitted,

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Washington, D. C.
April 15, 1950.